

REMARKS

Reconsideration and allowance of the claims pending in the application are requested.

Claims 1-48 are pending in the application. as follows:

1) Claims 1, 2, 3, 4, 7-18, 19 and 20-37 have been rejected under 35 USC 103 (a) as unpatentable over US Publication 2001/000532 to P. L Cofta, published June 28, 2001, filed December 19, 2000 (hereafter, "Cofta"), in view of US Publication 200040250066 to V. V Di Luoffo et al., published December 9, 2004, filed May 22, 2003 (hereafter, "DiLuoffo").

2) Claim 6 has been rejected under 35 USC 103 (a) as being unpatentable over Cofta, as modified by Di Luoffo, in view of US Publication 2004/0250066 to M. G. V Perttila et al., published December 2, 2004, filed June 2, 2003 (hereafter, "Perttila").

3) Claims 5, and 38-47 have been rejected under 35 USC 103 (a) as being unpatentable over Cofta, as modified by Di Luoffo, and Perttila, in view of USP 6,587,832 to Treyz et al., issued July 1, 2003, filed February 9, 2000 (hereafter, "Treyz")

Claims 5, 20 37 and 39 have been amended for clarification purposes.

Before responding to the rejection, Applicants would like to technically distinguish the subject matter of claims 1-48 (hereafter Sovio) from the cited references, as follows:

A. Cofta discloses a system for performing a cash transaction comprising a point-of-sale device interacting with a mobile phone to complete a transaction using a charge card electronically stored in a charge card terminal, after authentication of a mobile device with the charge card issuer. The point-of-sale terminal is matched to information on a transaction to the communication device and to the card entry at the charge card issuer. The electronic charge card checks the transaction and approves or disapproves. Approval or disapproval is sent to the mobile device at the point-of-sale terminal. The transaction is completed without currency in a communication device, as the point-of-sale connection is terminated. Cofta fails to disclose or suggest a pilot associated with a mobile phone, wherein, the pilot transfers a security key, and a mobile phone identification to a self-service terminal through a short-range data link (RFID) to establish a short-range communication link between the phone and the terminal.

B. DiLuoffo discloses a smartcard for secure transmission of post issuance data, i.e., instructions in data for adding, modifying or deleting data stored in a chip. The card is inserted into a card reader and the post data is transmitted in an XML message to a computer connected to the card reader and to a distribution server. A chip relay module establishes a secure session

with the distribution server. The post issuance data is transmitted in an XML message that has been provided with a code derived from an issuer's master key. Di Luoffo fails to disclose the smart card as a pilot device for initiating a radio link between the pilot device and a terminal for purposes of initiating a transaction at the terminal without currency.

C. Perttila discloses a coupon retrieval and redeeming system for providing an electronic coupon in response to a link established between a merchant-media arrangement and a mobile phone. An RFID tag is located in a merchant promotional article in the merchant media arrangement. The tag is used to communicate a merchant ID code to a mobile phone and associate the merchant promotional article with a coupon to be provided to the mobile phone. Alternatively, the merchant ID code can be communicated through a Bluetooth link. To receive the coupon information, the mobile phone user delivers the merchant media arrangement and receives the merchant ID code for generating an electronic coupon. The merchant-media arrangement extracts the user terminal ID and tag ID and provides the user with an option to download a JAVA midlet to correspond to the user request. After receiving the midlet, the user may store it for later activities. The user visits a merchant purchase center where a redemption data processing station validates the coupon by activating the midlet. The user can show a printed or electronically stored version of the coupon to a merchant personnel when obtaining redemption. The merchant personnel may validate the coupon by inserting a "secret" code that is used for validating the coupon. Perttila fails to supply the missing element in references A and B regarding transferring a security key and mobile phone identification from a pilot to a self service merchant for transaction purposes.

In any case, Perttila is disqualified as a reference under 35 USC 103(a), as provided by MPEP 706.02(l)(1). The subject application and USPA 2004/0243519 (Perttila) were, at the time the invention of the subject application was made, commonly owned by Nokia Corporation, the assignee of the subject application.

D. Treyz discloses a hand-held computer including a smart card attachment. for providing shopping assistance to a customer shopping in a retail store. When the smart card is attached purchasing is authorized. When the smart card is not attached purchasing is prohibited. In one embodiment, the users may enter grocery items into a handheld computer to create a grocer order. The order is transmitted to an auto-performance facility over a communication

network. The automated facility may supply a web-based grocery delivery service. The user may access the grocery deliver service or a network using a web browser. Orders may be created while the user is online with the grocery ordering service or may be created offline and transmitted to the grocery ordering service. Orders may be transmitted at periodic intervals when requested by the grocery delivery service, when desired by the user, continuously or using a combination of such transmission arrangements or any other suitable arrangement. Treyz fails to disclose a pilot device separated from a mobile phone initiating a radio link between a mobile phone and a point of sale terminal for transaction purposes.

Summarizing, the cited art, alone or in combination, fails to disclose a mobile device interacting with a merchant terminal to purchase items without currency after a radio link is established between the terminal and the mobile device via a pilot device interacting with the terminal through a different radio link.

Now turning to the rejection, Applicants responds to the indicated paragraphs of the Office Action, as follows:

Paragraphs 1 – 3:

Claims 1-4, and 7- 37 include features not disclosed in Cofta in view of DiLuoffo, as follows:

- A. Claims 1, 19, 33 and 37
 - (i) imprinting at least an association of the security key and a mobile phone identification into at least one associated portable pilot;

The Examiner acknowledges Cofta does not provide a pilot device. DiLuoffo does not supply the missing element. DiLuoffo at paragraph 23 discloses “the smart card is inserted into the card reader and the smart card is authenticated by mutual authentication between the chip and the website. DiLuoffo fails to disclose or suggest imprinting the mobile phone security code and identification into the smart card.

- c) transferring at least the association of the security key and the mobile phone identification directly from the pilot to a self-service merchant terminal through an initial short-range radio link; and

Cofta at paragraph 24 discloses a mobile phone or dedicated device is arranged solely to communicate with the point of sale terminal. Cofta fails to disclose a pilot device transferring a security key and identification number to a point of sale terminal. DiLuoffo fails to supply the missing element. DiLuoffo at paragraph 95 discloses the smart card is inserted into a card reader to transfer data to a terminal. DiLuoffo does not disclose or suggest transferring smart card information directly from the pilot device to the terminal.

d) establishing a secure short-range connection between the self-service terminal and the mobile phone based on the transferred security key and the mobile phone identification information, wherein the initial short-range radio link has a significantly smaller radio coverage than the secure short-range connection.

Neither Cofta nor DiLuoffo disclose a secure short range connection and an initial short range link, typically RFID enabling a mobile phone to conduct transactions with a point of sale terminal.

Summarizing Cofta in view of DiLuoffo fails to disclose the above features of claim 1 which features are repeated in claims 19, 33 and 37. The rejection of claims 1, 19, 33 and 37 is without support in the cited art and fails to satisfy the legal requirements of 35 USC 103 (a).

Moreover, the rejection of claims 1, 19, 33 and 37 fails to satisfy the requirement of 35 USC 103 (a), as set forth in MPEP 2141, First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. In the present instance a worker skilled in the would not be motivated to include smart card in the mobile device as a substitute for a card stored in a card issuer memory. Second , there must be a reasonable expectation of success. In the present instance, the smart card does not suggest or teach elements of the card 20 in Cofta which would render Cofta inoperative. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Neither reference discloses (i) RFID and short-range radio links; (ii) at least one portable pilot device (iii) transferring security information from the mobile phone to the pilot device; (iii) transferring the security information from the pilot device to the terminal to enable a user to conduct transactions

without currency via the portable pilot device or a user interface downloaded to the terminal. The cited art does not support the rejection of claims 1-48 under 35 USC 103 (a).

Withdrawal of the rejection under 35 USC 103 (a) and allowance of claims 1, 19, 33 and 37 are requested.

B. Claims 2-4:

Claims 2-4 depend from and further limit claim 1 and are patentable on the same basis as claim 1. Claim

C. Claim 3 and 5 :

Claims 3 and 5 define RFID as a radio link which is not shown or suggested in Cofta and/or DiLuoffo. Claim 3 and 5 are further distinguishable from the cited references.

D. Claims 7 -18:

The Examiner has not specifically addressed claims 7-18 which depend from and further limit claim 1. Accordingly, claims 7-18 are patentable on the same basis as claim 1. In any case, however, claims 7-18 include features not disclosed in Cofta and DiLuoffo , alone or in combination, as follows:

(i) Claim 7:

Applicants can find no disclosure or suggestion in the cited art in downloading a user interface to the merchant terminal, as described at page 10, lines 10-13.

(ii) Claims 8-18:

Applicants can find no disclosure or suggestion in the cited art wherein the pilot or smart card of DiLuoffo is provided a random number and a sequence number by the mobile device over a first radio link; computes and transfers a RES and session key to a point of sale terminal for establishing a secure connection with the mobile device and the terminal conducting transaction with the mobile device over a second radio link using encryption/decryption; one at a time authentication codes and payment applications.

E. Claims 20-26:

The Examiner has not specifically addressed claims 20-26 which depend from and further limit claim 19. Accordingly, claims 20-26 are patentable on the same basis as claim 19. In any case, however, claims 20-26 include features not disclosed in Cofta and DiLuoffo, alone or in combination, as follows:

(i) Claims 20/21

Applicants can find no disclosure in Cofta and or DiLuoffo relating to a RFID connection being established and a user interface displayed at the point of sale terminal.

(ii) Claims 22-26

Applicants can find no disclosure or suggestion in Cofta in view of DiLuoffo relating to the claimed features further describing the system of claim 19.

(F) Claims 27-32:

Applicants can find no disclosure or suggestion in Cofta in view of DiLuoffo relating to the claimed features describing a transponder or pilot device for use in an electronic payment scheme.

(G) Claims 34-36

Applicants can find no disclosure or suggestion in Cofta in view of DiLuoffo relating to the claimed features describing program code for implementing the method of claim 1.

Summarizing, dependent claims 2-4; 7-18; 20-26; and 34-36 disclose subject matter not shown or suggested in the cited references. Also, claims 27-32 describe subject matter not disclosed or suggested in the cited references. Withdrawal of the rejection and allowance of the dependent claims and claims 27-32 are requested. In any case, the rejected dependent claims depend from and further limit claims 1, 19, 32 and 37 and are patentable on the same basis as their respective base claim.

Paragraph 4:

Claim 6 includes features not disclosed in Cofta and DiLuoffo in view of Perttila, as follows:

Claim 6 depends from and further limits claim 1. Perttila does not supply the missing elements in Cofta and DiLuoffo. Perttila only disclose Bluetooth technology and fails to disclose the missing elements relating to an RFID link between the pilot and the terminal ; transferring security information from the pilot to the terminal, and establishing a short range connection between the terminal and the mobile device.

In any case, Perttila is disqualified as a reference, based on the subject application and Perttila were, at the time the invention of the subject application was made, commonly owned by Nokia Corporation, the assignee of the subject application.

Withdrawal of the rejection of claim 6 under 35 USC 103 (a) and allowance of claim 6 are requested.

Paragraph 5:

Claims 5, 38-37 include features not disclose or suggested in Cofta as modified by DiLuoffo and Perttila in view of Treyz, as follows:

A. Claim 5:

(i) The method of claim 1, wherein the coverage area of the short-range radio link is under 10 centimeters for the initial short-range radio link and a RFID connection between the mobile phone device and the pilot .

Treyz at col. 15, lines 36-47 discloses "...a handheld computing device 12 may include accessories and expansion components 98. An expansion slot 100 may be used to add expansion cards or accessories to handheld computing device 12. For example, a flash card containing software or other content may be added as an expansion module. Another accessory that may be added is a bar code scanner or a radio-frequency identification (RFID) unit." Treyz fails to disclose (i) a portable pilot device or (ii) a RFID connection between the mobile phone device and the pilot, as described in Sovio at page 3, lines 25-28

Cofta modified by DiLuoppo and Perttila all fail to disclose a portable pilot carried as a wand or fob by a user for interacting with a mobile phone or like device and a self-service terminal. DiLuoppo in Fig. 1A disclose a smart card installed in a card reader. Even

assuming the DiLuoppo smart card can be installed in a mobile phone, as taught by Treyz, there is no disclosure in the references, alone or in combination, of a portable pilot device carried by the user as a wand for interacting with a mobile phone and a self-service terminal via RFID connections.

The cited art fails to disclose or suggest the claimed subject matter. **In any case, Perttila is disqualified as a reference, based on the subject application and Perttila were, at the time the invention of the subject application was made, commonly owned by Nokia Corporation, the assignee of the subject application.**

Withdrawal of the rejection under 35 USC 103 (a) and allowance of claim 5 are requested. In any case, claim 5 depends from and further limits claim 5 and is patentable on the same basis thereof.

B. Claims 38-47:

The cited references, alone or in combination, fail to disclose the claimed features of claims 38-48, as follows:

(i) The method of claim 37, wherein the imprinting step further comprises:

limiting the validity of the at least one portable pilot based on a predefined policy constraint.

There is no disclosure or suggestion in the cited references alone of a portable pilot device, as discussed in connection with the consideration of claims 1, 19, 33 and 37.

(ii). The method of claim 37, wherein the predefined policy constraint includes at least one of a maximum purchase value and a maximum time limit in a slave device.

Treyz at col. 46, lines 43-61 discloses limiting transactions for a handheld computing device but not in a slave device, as described in Sovia at page 11, lines 28-31..

(iii) The method of claim 37 further comprising: storing a list of prohibited purchase items in a slave device.

See item (ii) above.

(iv) The method of claim 37 further comprising: transmitting a list of purchased items from the terminal to the slave device.

See item (ii) above.

(v). The method of 37 further comprising: comparing the purchased items to prohibited items stored in the slave device.

See item (ii) above.

(vi). The method of claim 37 further comprising: verifying in the slave device that no purchased item is a prohibited item.

See item (ii) above.

(vii). The method of claim 37 wherein a policy restraints limits usage of the slave device to a maximum value for a purchased item.

See item (ii) above.

(viii). The method of claim 37 wherein the policy restraints limits usage of the slave device to a maximum time period.

See item (ii) above.

(ix). The method of claim 37 wherein the terminal receives a signal from the slave indicating approval or denial of a purchased item.

See item (ii) above.

(x). The method of claim 37 wherein the terminal displays approval or denial of the purchased items after receiving a signal from the slave device.

See item (ii) above.

(xi) The method of claim 37 wherein the slave device touches or holds the slave device in close proximity to the terminal to authorize payment for the purchased after the terminal displays approval of the purchased by the slave device.

See item (ii) above.

Paragraph 6:

Applicants have fully considered the entire scope of the references in preparing a response to the rejections.

Paragraph 7:

Applicants have considered USP 5,943,624 (Fox); USPA 20020143655 (Elston), and USPA 20030055738 (Alie) and can find no disclosure or suggestion of at least one portable pilot device interacting with a mobile phone and a self-service merchant terminal via RFID connections for initiating a short range connection between the self-service terminal and the mobile phone for conducting transaction without the use of currency. At best, the cited, but not applied art, is only cumulative to the cited art.

Patentability Support for New Claim:

Applicants have added claim 49 which combines claim 1 with claims 7 and 16.

The cited references, alone or in combination, fail to disclose or suggest a method for enabling a user in a mobile environment to conduct transaction with a self-service terminal via (i) a mobile phone device and at least one associated portable pilot coupled together via a RFID connection; (ii) transferring mobile phone security information to the terminal via a RFID connection between the portable pilot and the terminal; (iii) the terminal establishing a secure connection with the mobile phone via one time authentication codes for transaction purposes; (iv) imitating transactions with the terminal via the portable pilot under the control of a user or (v) a user interface downloaded to the terminal for use by the using in entering transactions into the terminal

CONCLUSION:

Having amended claims 5, 20, 37 and 39 for clarification purposes; distinguished the claims from the cited art; considered the cited, but not applied art and supported the patentability of New Claim 49, applicants request entry of the amendment; withdrawal of the rejection; allowance of the claims, and passage to issue of the case.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. 13-4503, Order No. 4208-4169. A DUPLICATE OF THIS DOCUMENT IS ATTACHED.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a

petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 13-4503, Order No. 4208-4169 A DUPLICATE OF THIS DOCUMENT IS ATTACHED.

Respectfully submitted,
MORGAN & FINNEGAN, L.L.P.

Dated: November 17, 2005

By: Joseph C. Redmond, Jr.
Joseph C. Redmond, Jr.
Registration No. 18,753
(202) 857-7887 Telephone
(202) 857-7929 Facsimile

Correspondence Address:

MORGAN & FINNEGAN, L.L.P.
3 World Financial Center
New York, NY 10281-2101